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Docket No.: SON-2024
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Motoshi ASANO et al.

Confirmation No.: 3692

Application No.: 09/774,682

Art Unit: 3628

Filed: February 1, 2001

Examiner: F. Poinvil

For: ELECTRONIC-MONEY SETTLEMENT
METHOD AND INFORMATION
PROCESSING APPARATUS THEREFOR

**RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF (37 C.F.R. 41.37) AND
TRANSMITTAL OF APPEAL BRIEF**

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Notice of Non-Compliant Appeal Brief (37 C.F.R. 41.37)
mailed on October 17, 2008.

An Appellant's Brief on Appeal for the above-referenced application is being filed
herewith. An Appeal Brief and fee was filed on October 2, 2008.

Pursuant to practice and procedures within the U.S. Patent and Trademark Office, any
previously paid appeal fees set forth in 37 CFR 41.20 for filing a notice of appeal, filing an appeal
brief, and requesting an oral hearing (if applicable) will be applied to the new appeal on the same
application as long as a final Board decision has not been made on the prior appeal. M.P.E.P.
§1204.01.

Please apply the fee paid on October 2, 2008 for the Appeal Brief Transmittal.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: November 13, 2008

Respectfully submitted,

By 

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APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an Appeal Brief under 37 C.F.R. §41.37 appealing the final decision of the Examiner dated April 2, 2008. Each of the topics required by 37 C.F.R. §41.37 is presented herewith and is labeled appropriately. This brief is in furtherance of the Final Office Action on April 2, 2008.

A Notice of Appeal was filed in this case on July 2, 2008, along with a Request for Panel Review and a *one-month* extension.

The Notice of Panel Decision From Pre-Appeal Brief Review mailed on August 5, 2008 ("the Decision") indicates that claims 1, 3-4 and 9-38 remain rejected.

The Decision further indicates that the extendable time period for the filing of the Appellant's Brief will be reset to be one month from the mailing of the Decision. With a one-month extension, the filing of the Appellant's Brief is timely.

I. REAL PARTY IN INTEREST

Sony Corporation of Tokyo, Japan ("Sony") is the real party in interest of the present application. An assignment of all rights in the present application to Sony was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 011767, frame 0481**.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Within the Final Office Action of April 2, 2008:

Paragraph 3 of the Final Office Action includes a rejection of claims 1, 3, 4, 9-38 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka) in view of Japanese Application Publication number 62-264364 (Kamimura) and/or Japanese Application Publication number 11-161832 (Purse Japan:KK) and U.S. Patent No. 5,679,938 (Templeton).

Thus, the status of the claims is as follows:

Claim 1: (Rejected)

Claim 2: (Canceled)

Claims 3-4: (Rejected)

Claims 5-8: (Canceled)

Claims 9-38: (Rejected)

No claims are indicated within the Final Office Action to contain allowable subject matter.

Accordingly, Appellant hereby appeals the final rejection of claims 1, 3-4 and 9-38 which are presented in the Claims Appendix.

IV. STATUS OF AMENDMENTS

Subsequent to the final rejection of April 2, 2008, no amendment After Final Action has been filed.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following description is provided for illustrative purposes and is not intended to limit the scope of the invention.

The present invention relates to information processing systems and information processing apparatuses. In particular, the present invention can be applied to an electronic money system using portable information devices. According to the present invention, when an amount of electronic money deposited in an information processing apparatus is insufficient for a payment amount, by loaning money up to a predetermined limit to the user of the information processing apparatus and recording the amount of the loan in the information processing apparatus and a management center, the user can use electronic money even if a small amount of electronic money is deposited in the information processing apparatus.

<u>Claim 1</u> - Claim 1 is drawn to an electronic-money settlement method comprising the steps of:	
determining if an identification code for a portable electronic device (5) is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device (5) as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device (5) as an enabled device (5);	Specification page 12, line 6 to page 13, line 15
recording, in said enabled device (5) and said management center (3), information on a deposited amount of money, said information being stored in said enabled device (5) in the form of electronic money representing a monetary value; and	Specification page 9, line 18 to page 10, line 8, page 14, lines 12-18
recording, in said enabled device (5) and said management center (3), information on a loan made to the user of said enabled device (5) up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device (5),	Specification page 24, line 25 to page 25, line 12
wherein said management center (3) calculates interest on the loan at a predetermined frequency in step SP25 (Specification Figure 5, page 14, lines 19-38, page 15, lines 14-17), and uses the calculation result to update said information on the loan in step SP26.	Specification Figure 5, page 15, lines 14-17

<u>Claim 9</u> - Claim 9 is drawn to an electronic-money settlement method comprising the steps of:	
loading electronic money from a portable electronic device (5) into an information processing apparatus, said electronic money having a monetary value;	Specification page 24, line 25 to page 25, line 12
determining if an identification code for said portable electronic device (5) is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device (5) as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device (5) as an enabled device (5);	Specification page 12, line 6 to page 13, line 15
establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity; and	Specification page 24, line 25 to page 25, line 12
recording said loan in said portable electronic device (5).	Specification Figure 5, page 14, lines 19-38, page 15, lines 14-17

<u>Claim 17</u> - Claim 17 is drawn to an electronic-money settlement apparatus comprising:	
information processing means (3, 6, 8, 10) for establishing a loan when a payment amount exceeds a monetary value of electronic money, said payment amount being a purchase price of a commodity;	Specification page 24, line 25 to page 25, line 12
means (6, 8, 10) for loading said electronic money from a portable electronic device (5) to said information processing means, said electronic money having said monetary value;	Specification page 24, line 25 to page 25, line 12
means determining if an identification code for said portable electronic device (5) is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device (5) as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device (5) as an enabled device (5); and	Specification page 12, line 6 to page 13, line 15
means (6, 8, 10) for recording said loan in said enabled device (5).	Specification Figure 5, page 14, lines 19-38, page 15, lines 14-17

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal are as follows:

Whether the Examiner erred in rejecting claims 1, 3, 4, 9-38 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka) in view of Japanese Application Publication number 62-264364 (Kamimura) and/or Japanese Application Publication number 11-161832 (Purse Japan:KK) and U.S. Patent No. 5,679,938 (Templeton).

This issue will be discussed hereinbelow.

VII. ARGUMENT

In the Office Action of April 2, 2008:

The Examiner erred in rejecting claims 1, 3, 4, 9-38 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka) in view of Japanese Application Publication number 62-264364 (Kamimura) and/or Japanese Application Publication number 11-161832 (Purse Japan:KK) and U.S. Patent No. 5,679,938 (Templeton).

For at least the following reasons, Appellant submits that this rejection is both technically and legally unsound and should therefore be reversed.

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below.

Examiner erred in rejecting claims 1, 3, 4, 9-38 under 35 U.S.C. 103(a) as being unpatentable over UK Patent Application No. GB 2 303 956 to Tomoyuki Nonaka et al. (Nonaka) in view of Japanese Application Publication number 62-264364 (Kamimura) and/or Japanese Application Publication number 11-161832 (Purse Japan:KK) and U.S. Patent No. 5,679,938 (Templeton).

This rejection is traversed at least for the following reasons.

Nonaka - Nonaka arguably teaches an electronic purse loan system wherein a repayment term storage may be provided in the personal information storage 34 in the center 3 (Nonaka at page 19, line 23 to page 20, line 5).

Nonaka arguably teaches the presence of an ID number storage 60 (Nonaka at page 7, line 19).

Nonaka **fails** to disclose, teach or suggest **an absence** of an ID number from the storage 60 as identifying an ID card 1 as an enabled device.

Instead, Nonaka merely determines whether or not the ID number is “cataloged” (Nonaka at Figure 3, steps S106 and S121; Figure 4, steps S206 and S221; Figure 6, steps S308; Figure 8, steps S406 and S420; Figure 11, steps S506).

- ***Thus, Nonaka fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.***

Within claim 1, information on a loan is recorded in both the enabled device (5) and the management center (3).

However, Nonaka fails to disclose, teach or suggest information on a loan is recorded in both the IC Card 1 and the center 3 of Nonaka.

- ***Thus, Nonaka fails to disclose, teach or suggest the step of recording, in said enabled device and said management center, information on a loan made to the user of said enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device.***

The Final Office Action contends that Figure 2a and 2b and 5 and 10 of Nonaka show the format of the data storage in the electronic purse 2 (Final Office Action at page 3).

In response, Figure 2a and 2b and 5 and 10 of Nonaka fail to show the format of the data storage in the electronic purse 2.

Instead, Nonaka arguably teaches the presence of the personal information storage 34 in the center 3 (Nonaka at Figure 1, page 19, line 23 to page 20, line 5).

Figures 2a and 2b and 5 and 10 of Nonaka depict reference number 34.

Also note that the electronic purse 2 of Nonaka is shown within Figure 1 to be different than the personal information storage 34.

- ***Thus, Nonaka fails to disclose, teach or suggest a method wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.***

Nevertheless, the Final Office Action contends, without providing any supporting evidence, that Nonaka clearly teaches a management center providing a loan to a customer and

recording the loan data at both the management center and a portable device of the user (Final Office Action at page 5).

In response to this contention, please note that Nonaka is *silent* regarding any interest calculation.

But as a gap-filler, the Final Office Action contend, *without providing any supporting evidence*, that loans are usually provided wherein the loan provider's intention is to charge interest on the loan amount so that a profit is made because of the risk involving in borrowing the loan amount and also because of administrative costs/functions (Final Office Action at page 5).

In response, this contention is conclusory and is *not based upon any objective teaching* found within Nonaka. Specifically, the Final Office Action *fails* to show where within Nonaka there is to be disclosed the "*intention of a loan provider*".

Purse Japan:KK - The Office Action cites Purse Japan:KK for the features that are deficient from within Nonaka.

However, Purse Japan:KK *fails* to disclose, teach or suggest an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

- ***Thus, Purse Japan:KK fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list,***

a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and

an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

Kamimura - The Office Action cites Kamimura for the features that are deficient from within Nonaka.

However, Kamimura fails to disclose, teach or suggest an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

- ***Thus, Kamimura fails to disclose, teach or suggest the features and steps of determining if an identification code for said portable electronic device is listed on a negative list,***

a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and

an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

The claims include the features and steps of *determining if an identification code for said portable electronic device is listed on a negative list,*

a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and

an absence of said identification code from said negative list identifying said portable electronic device as an enabled device.

Templeton - The Office Action readily admits an absence of these features within Nonaka, Purse Japan:KK, and Kamimura (Office Action at page 6). Templeton has been cited to account for these features.

In response, **Templeton** arguably teaches that the magnetic stripe reader includes a magnetic read head (not shown) positioned adjacent a card swipe slot 70, and is operative for

electronically reading a magnetic stripe 75 on the back of a identification card 80 or data card (not shown) (Templeton at column 12, lines 13-16).

An "identification card" can mean a drivers license or other card bearing identifying information associated with a customer (Templeton at column 9, lines 58-60).

The identifying information typically includes the customer's name and address, and may also include the customer's date of birth, social security number, drivers license number, other identifying numbers, gender, etc. (Templeton at column 9, lines 60-63).

In this regard, Templeton fails to teach information on a deposited amount of money being stored in identification card 80 or data card in the form of electronic money representing a monetary value.

Templeton arguably teaches that the MICR reader includes a MICR read head (not shown) positioned adjacent a MICR slot 55, and is operative for electronically reading the MICR characters 60 on a check 65 (Templeton at column 12, lines 9-13).

Templeton arguably teaches that the host computer 35 then accesses the negative file 85, which contains bad check data that has been accumulated by the check acceptance service (Templeton at column 13, lines 18-20).

However, Templeton fails to disclose, teach, or suggest the "bad check data" as including an identification code for the check 65.

Instead, Templeton arguably teaches that this data may be accessed using the customer's checking account number, drivers license number, or other transaction data (Templeton at column 13, lines 20-22).

Templeton arguably teaches that the negative file 85 includes data indicating that previous checks tendered by the customer were returned for some reason, and have not been collected (Templeton at column 13, lines 22-25).

However, Templeton fails to disclose, teach, or suggest the “previous checks” and check 65 as being one in the same.

Thus, Templeton fails to disclose, teach, or suggest the features and steps of *determining if an identification code for said portable electronic device is listed on a negative list*.

Withdrawal of this rejection and allowance of the claims is respectfully requested.

Conclusion

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite.

Reversal of the Examiner’s decision is respectfully requested.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: November 13, 2008

Respectfully submitted

By 

Ronald P. Kananen

Registration No.: 24,104

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Attorneys for Applicant

CLAIMS APPENDIX

1. An electronic-money settlement method comprising the steps of:

determining if an identification code for a portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device; recording, in said enabled device and a management center, information on a deposited amount of money, said information being stored in said enabled device in the form of electronic money representing a monetary value; and

recording, in said enabled device and said management center, information on a loan made to the user of said enabled device up to a predetermined limit when a payment amount exceeds the remaining amount of the electronic money stored in said enabled device,

wherein said management center calculates interest on the loan at a predetermined frequency, and uses the calculation result to update said information on the loan.

2. (Canceled)

3. An electronic-money settlement method according to Claim 1, wherein, when the loan exceeds a predetermined limit, said management center prohibits the use of electronic money by said enabled device.

4. An electronic-money settlement method according to Claim 1, wherein said management center updates a record of the remaining amount of the electronic money stored in said enabled device when being instructed to store electronic money in said enabled device, and updates the remaining amount of the electronic money stored in said enabled device when being accessed by said enabled device so that priority is given to liquidation of the loan.

5-8. (Canceled)

9. An electronic-money settlement method comprising the steps of:

loading electronic money from a portable electronic device into an information processing apparatus, said electronic money having a monetary value;

determining if an identification code for said portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device;

establishing a loan when a payment amount exceeds said monetary value of said electronic money, said payment amount being a purchase price of a commodity; and

recording said loan in said enabled device.

10. An electronic-money settlement method according to Claim 9, wherein prior to the step of loading said electronic money, the method further includes the step of:

depositing said electronic money into said enabled device.

11. An electronic-money settlement method according to Claim 9, further comprising the steps of:

adding said loan to said monetary value, the sum being a balance;

subtracting said payment amount from said balance, the difference being a remaining amount; and

updating said monetary value of said electronic money within portable electronic device with said remaining amount.

12. An electronic-money settlement method according to Claim 11, further comprising the step of:

repaying said loan recorded in said enabled device prior to increasing said monetary value of said electronic money.

13. An electronic-money settlement method according to Claim 9, further comprising the steps of:

calculating interest on said loan at a predetermined frequency, and

using said interest to update an amount of said loan.

14. An electronic-money settlement method according to Claim 9, further comprising the step of:

recording in said enabled device a history of use of said enabled device a history.

15. An electronic-money settlement method according to Claim 9, further comprising the step of:

prohibiting use of said electronic money by said enabled device when said loan exceeds a predetermined limit.

16. An electronic-money settlement method according to Claim 9, the step of loading said electronic money includes the step of:

inducing power into said enabled device.

17. An electronic-money settlement apparatus comprising:

information processing means for establishing a loan when a payment amount exceeds a monetary value of electronic money, said payment amount being a purchase price of a commodity;

means for loading said electronic money from a portable electronic device to said information processing means, said electronic money having said monetary value;

means for determining if an identification code for said portable electronic device is listed on a negative list, a presence of said identification code on said negative list identifying said

portable electronic device as a disabled device and an absence of said identification code from said negative list identifying said portable electronic device as an enabled device; and

means for recording said loan in said enabled electronic device.

18. An electronic-money settlement apparatus according to Claim 17, wherein said enabled device is a non-contact memory card having an identification code, power being induced within said non-contact memory card.

19. An electronic-money settlement apparatus according to Claim 17, wherein said information processing means subtracts said payment amount from said balance, the difference being a remaining amount,

said information processing means updating said monetary value of said electronic money within portable electronic device with said remaining amount.

20. An electronic-money settlement apparatus according to Claim 17, further comprising:

means for depositing said electronic money into said enabled device.

21. An electronic-money settlement apparatus according to Claim 17, further comprising:

means for calculating interest on said loan at a predetermined frequency, said interest being used to update an amount of said loan.

22. An electronic-money settlement apparatus according to Claim 17, further comprising:

means for prohibiting use of said electronic money by said enabled device when said loan exceeds a predetermined limit.

23. An electronic-money settlement apparatus according to Claim 17, further comprising:

means for recording in said enabled device a history of use of said enabled device.

24. An electronic-money settlement method according to Claim 1, wherein use of said disabled device is prohibited.

25. An electronic-money settlement method according to Claim 1, wherein the identification code for said enabled device is recorded on said negative list when a limited amount of credit is exceeded by the calculation result.

26. An electronic-money settlement method according to Claim 1, wherein the identification code for said disabled device is deleted from said negative list upon repayment of the loan.

27. An electronic-money settlement method according to Claim 1, wherein the identification code for said portable electronic device is recorded on said negative list when the amount of electronic money deposited in said portable electronic device is illegally changed.

28. An electronic-money settlement method according to Claim 1, wherein the identification code for said portable electronic device is recorded on said negative list when said portable electronic device is illegally used.

29. An electronic-money settlement method according to Claim 9, wherein use of said disabled device is prohibited.

30. An electronic-money settlement method according to Claim 9, wherein the identification code for said enabled device is recorded on said negative list when a limited amount of credit is exceeded by the calculation result.

31. An electronic-money settlement method according to Claim 9, wherein the identification code for said disabled device is deleted from said negative list upon repayment of the loan.

32. An electronic-money settlement method according to Claim 9, wherein the identification code for said portable electronic device is recorded on said negative list when the amount of electronic money deposited in said portable electronic device is illegally changed.

33. An electronic-money settlement method according to Claim 9, wherein the identification code for said portable electronic device is recorded on said negative list when said portable electronic device is illegally used.

34. An electronic-money settlement apparatus according to Claim 17, wherein use of said disabled device is prohibited.

35. An electronic-money settlement apparatus according to Claim 17, wherein the identification code for said enabled device is recorded on said negative list when a limited amount of credit is exceeded by the calculation result.

36. An electronic-money settlement apparatus according to Claim 17, wherein the identification code for said disabled device is deleted from said negative list upon repayment of the loan.

37. An electronic-money settlement apparatus according to Claim 17, wherein the identification code for said portable electronic device is recorded on said negative list when the amount of electronic money deposited in said portable electronic device is illegally changed.

38. An electronic-money settlement apparatus according to Claim 17, wherein the identification code for said portable electronic device is recorded on said negative list when said portable electronic device is illegally used.

EVIDENCE APPENDIX

There is no other evidence which will directly affect or have a bearing on the Board's decision in this appeal.

RELATED PROCEEDINGS APPENDIX

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.